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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/951,276	10/16/1997	DAVID G. MCCARTHY	402-038-19	1410

7590 06/14/2005

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EXAMINER

HAMMOND, BRIGGITTE R

ART UNIT PAPER NUMBER

2833

DATE MAILED: 06/14/2005

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 08/951,276  
Filing Date: October 16, 1997  
Appellant(s): MCCARTHY, DAVID G.

**MAILED**  
JUN 14 2005  
**GROUP 2800**

\_\_\_\_\_  
Mark Stone  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 3, 2005

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Claimed Subject Matter***

The summary of invention contained in the brief is correct.

**(6) *Ground of Rejection to be reviewed on Appeal***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appendix***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Evidence Relied Upon**

4747788	Byrne	5-1988
4511198	Mitchell et al.	4-1985

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne 4,747,788 in view of Mitchell et al. Regarding claims 1 and 16 Byrne discloses a retractable receptacle 150 with sidewalls (front side of box 152) adapted to be mounted in an opening in a top surface of an article of furniture 104. Byrne discloses the top 162 of the receptacle sitting in a recess portion (see figure 2) and being "substantially" planar with a top surface of the article of furniture (see col. 7, lines 10-12). Byrne does not disclose the top of the receptacle unit being "planar" with the top surface of the article of furniture. However, Mitchell et al. disclose an article of furniture 10 with a top surface 12, a receptacle unit 30 with a top surface (top of 50 in figure 2), a receptacle 48, a housing 30 mounted on an underside of the furniture 10 and a disk (not shown) sitting in recess 16 for providing a two-piece uninterrupted working surface (see

col. 3, lines 62-66). It would have been obvious to one of ordinary skill in the art to modify the receptacle of Byrne with the planar teachings of Mitchell since Mitchell teaches that planar surfaces provide uninterrupted workspaces (col.3, line 66).

Regarding claim 2, the receptacle of Byrne displaces in a direction perpendicular to the top surface of the article of furniture (see fig. 1).

Regarding claims 3, 12, 13 and 17, Byrne does not show each sidewall having a receptacle. However, on page 9, lines 54-57 Byrne discloses that the receptacle box 152 (which includes the walls) could be double sided to accommodate multiple receptacles. It would have been obvious to modify the receptacle of Byrne to include receptacles on multiple sidewalls to supply multiple outlet capacity.

Regarding claims 4,5,7 and 18, Byrne discloses a gap space 166, to permit transmission lines to extend through and means 168 for covering the gap space.

Regarding claims 9 and 10, since Byrne discloses the covering means as being a brush 168 and the brush acts as a screen.

Regarding claims 14 and 15, the receptacle of Byrne is generally rectangular/square (see figs. 1,2,4, and 5).

Claims 1,2, 4-7, 10, 12-15, 19 and 20 are rejected under 35 U.S.C. 103 (a) as being as being unpatentable over Mitchell et al. Mitchell et al. disclose an article of furniture 10 with a top surface 12, a retractable receptacle unit 30 with a top surface (top of 50 in figure 2), a receptacle 48, and a housing 30 mounted on an underside of the article of furniture 10. Mitchell et al. do not disclose the top of the receptacle unit being planar with a top surface of the article of furniture. However, Mitchell et al. disclose a

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disk (not shown) for covering the receptacle unit and providing a planar surface with the article of furniture (see col. 3, lines 62-66). It has been held to be within the general skill of a worker in the art to make plural parts unitary as a matter of obvious engineering choice. In re Larson, 144 USPQ 347 (CCPA 1965); In re Lockart, 90 USPQ 214 (CCPA 1951). Therefore, it would have been obvious to one of ordinary skill to modify the receptacle unit of Mitchell et al. by making a one piece top such that the top of the receptacle unit would be flush with the article of furniture to provide an uninterrupted surface to the article of furniture and the retractable receptacle unit as taught by Mitchell et al.

Regarding claim 2, the receptacle unit of Mitchell et al. displaces in a direction perpendicular to the top surface of the article of furniture (see figs. 2-7).

Regarding claims 4 and 5, the receptacle unit of Mitchell et al. has a gap space (at 16) that is of a sufficient dimension to permit a transmission line when the receptacle unit is in a retracted position.

Regarding claim 6, the receptacle unit of Mitchell et al. further includes means 118 for biasing and locking means 116.

Regarding claims 7 and 10, Mitchell et al. also discloses means (a disk, not shown) for covering the gap (see col. 3, lines 62-66).

Regarding claims 12-15, the receptacle unit of Mitchell et al. has a generally rectangular/square shape (as shown in the drawings) and a plurality of sidewalls with at least one receptacle (see col. 4, lines 42-45).

**(11) Response to Arguments**

In response to Appellant's arguments on page 9, lines 14-18 that "modification of the Byrne patent would defeat the intended purpose and express objective of the arrangement of the structure disclosed by Byrne". The Examiner disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Byrne discloses the invention substantially as claimed except for the surfaces being uninterrupted. The top of Byrne could/would fit in the recess 16 taught by Mitchell to provide an uninterrupted surface.

In response to Appellant's arguments on page 10, lines 22-26 that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument on page 12, line 1, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Mitchell discloses the invention substantially as claimed except the top of the receptacle unit being planar with a top surface of the article of furniture. However, Mitchell et al. do disclose a disk (not shown) for covering the receptacle unit and providing a planar surface with the article of furniture (see col. 3, lines 62-66). It has been held to be within the general skill of a worker in the art to make plural parts unitary as a matter of obvious engineering choice.

In response to applicant's argument on page 13, line 6, that the structural arrangement of Mitchell is different. Applicant's arguments do not clearly point out the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the claims avoid such references or objections.

For the above reasons, it is believed that the rejections should be sustained.



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Respectfully submitted,  
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June 9, 2005

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